

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 13

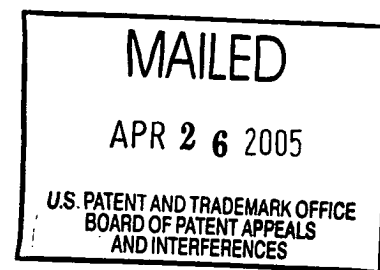
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RONALD R. FOSTER

Appeal No. 2005-0651
Application 09/826486

ON BRIEF



Before THOMAS, BARRY, and MACDONALD, **Administrative Patent Judges.**

MACDONALD, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-9 and 13. Claims 10-12 have been canceled.

Invention

Appellant's invention relates to a biometric security system formed as a single integrated circuit using standard complementary metal oxide semiconductor (CMOS) processes, and includes a CMOS image sensor 16, a signal processor 18, which may be a microprocessor or a digital signal processor ("DSP"), non-volatile memory 20, and an input/output section 22. Appellant's specification at page 5, lines 3-6.

Claim 1 is representative of the claimed invention and is reproduced as follows:

1. An appliance integrated biometric security system comprising:

an electronic appliance; and

an integrated biometric security system formed in a single integrated circuit die and including a CMOS image sensor, a signal processor, and non-volatile memory.

References

The references relied on by the Examiner are as follows:

Maurinus et al. (Maurinus)	5,606,365	Feb. 25, 1997
Hundt	6,028,773	Feb. 22, 2000
Hattori et al. (Hattori)	6,225,676	May 1, 2001
		(Filed February 19, 1999)

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Rejections At Issue

Claims 1-8 and 13 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Hundt and Hattori.

Claim 9 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Hundt, Hattori, and Maurinus.

Throughout our opinion, we make references to the Appellant's briefs, and to the Examiner's Answer for the respective details thereof.¹

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellant and the Examiner, for the reasons stated *infra*, we affirm the Examiner's rejection of claims 1-9 and 13 under 35 U.S.C. § 103.

Only those arguments actually made by Appellant have been considered in this decision. Arguments that Appellant could have made but chose not to make in the brief have not been considered. We deem such arguments to be waived by Appellant [see 37 CFR § 41.37(c)(1)(vii) effective September 13, 2004 replacing 37 CFR § 1.192(a)].

¹Appellant filed an appeal brief on March 29, 2004. The Examiner mailed an Examiner's Answer on June 15, 2004.

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Appellant has indicated that for purposes of this appeal the claims stand or fall together. See page 3 of the brief. We read this as the claims stand together in two groups based on the two grounds of rejection. Appellant has fully met the requirements of 37 CFR § 1.192 (c)(7) (July 1, 2002) as amended at 62 Fed. Reg. 53169 (October 10, 1997), which was controlling at the time of Appellant's filing of the brief. 37 CFR § 1.192 (c)(7) states:

Grouping of claims. For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

We will, thereby, consider Appellant's claims as standing or falling together in two groups, and we will treat:

Claim 1 as a representative claim of Group I (claims 1-8 and 13); and

Claim 9 as a representative claim of Group II (claim 9).

If the brief fails to meet either requirement, the Board is free to select a single claim from each group and to decide the appeal of that rejection based solely on the selected representative claim. **In re McDaniel**, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465

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(Fed. Cir. 2002). **See also In re Watts**, 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1457 (Fed. Cir. 2004).

**I. Whether the Rejection of Claims 1-8 and 13 Under
35 U.S.C. § 103 is proper?**

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the invention as set forth in claims 1-8 and 13. Accordingly, we affirm.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a **prima facie** case of obviousness. **In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). **See also In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. **In re Fine**, 837 F.2d 1071, 1074; 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellant. **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. **See also Piasecki**, 745 F.2d at 1472, 223 USPQ at 788.

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An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and argument." **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." **In re Lee**, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

With respect to independent claim 1, Appellant argues at page 6 of the brief, Hundt teaches away from forming an integrated biometric security system on a single integrated circuit die. We find this argument unpersuasive. "A reference may be said to teach away when a person of ordinary skill, upon reading the reference . . . would be led in a direction divergent from the path that was taken by the applicant." **In re Haruna**, 249 F.3d 1327, 1336, 58 USPQ2d 1517, 1522 (Fed. Cir. 2001). We do not find this to be the situation before this Board. At most it can be argued that Hundt teaches forming an integrated biometric security system on plural integrated circuit dies. However, we find that this difference does not constitute teaching away from a single die.

Also, Appellant argues at page 7 of the brief, one of ordinary skill in the art would not be motivated to modify Hundt's device in view of Hattori. Appellant argues that the Examiner's "sweeping statement regarding the desirability of 'more integration,' 'lower costs,' and 'smaller chips' in the microprocessor industry in no way meets the Examiner's burden of 'present[ing] a convincing line of reasoning' as to why the modification would have been obvious." Appellant also argues at page 8 of the brief, "the Examiner's rationale appears to be nothing more than a thinly veiled use of impermissible hindsight." We find Appellant's argument unpersuasive.

The fact that a motivation is "sweeping" in no way impacts the Examiner's establishment of a **prima facie** case of obviousness. Rather, to establish a **prima facie** case of obviousness, the Examiner must show "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." **In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). "The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved." **In re Kotzab**, 217 F.3d 1365, 1370, 55 USPQ2d 1313,

1317 (Fed. Cir. 2000). In the case before us, we find that the Examiner has pointed to an explicit statement in the prior art at column 1, lines 10-12, of Hattori. We find it abundantly clear that the combined teachings of Hundt and Hattori would have suggested the invention of claim 1 without the use of impermissible hindsight.

Appellant also argues at page 8 that "[t]he Hattori patent is not directed in any way to the biometric security system field." We find this argument unpersuasive. We must determine what is analogous prior art for the purpose of analyzing the obviousness of the subject matter at issue. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." **In re Oetiker**, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). **See also In re Deminski**, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986); **In re Clay**, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem."); **Wang**

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Laboratories Inc. v. Toshiba Corp., 993 F.2d 858, 865, 26 USPQ2d 1767, 1774 (Fed. Cir. 1993); and **State Contracting & Eng 'g Corp. v. Condotte America, Inc.**, 346 F.3d 1057, 1069, 68 USPQ2d 1481, 1490 (Fed. Cir. 2003). Where the general scope of a reference is outside the pertinent field of endeavor, the reference may be considered analogous art if subject matter disclosed therein is relevant to the particular problem with which the inventor is involved.

In the case before us, we find that the inventor is addressing the problem of integrated circuit manufacturing and packaging (see Appellant's specification at page 2 at lines 18-21) of a biometric security device. We find that the analogous art includes the area of general semiconductor manufacturing and packaging into which the Hattori patent falls. We also find that Hattori addresses and solves the same problem confronted by Appellant.

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 103.

II. Whether the Rejection of Claim 9 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the invention as set forth in claim 9. Accordingly, we affirm.

With respect to dependent claim 9, Appellant argues at page 9 of the brief that one of ordinary skill in the art would not be motivated to modify the combination of Hundt's and Hattori further in view of Maurinus. Further, Appellant argues, "[t]he Examiner cannot simply find any reference that includes a pixel defect map and assert that it would have been obvious to combine that reference with Hundt's device. We find Appellant's argument unpersuasive.

We have reviewed the Maurinus reference and find that Appellant has greatly oversimplified the teachings therein. We find that in addition to teaching a pixel defect map, Maurinus also teaches throughout (e.g. col. 6, lines 11-13) that such a pixel defect map can be used to improve image processing in image capture systems. We find that this is more than sufficient motivation to modify the image processing system as taught by Hundt and Hattori.

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Therefore, we will sustain the Examiner's rejection under
35 U.S.C. § 103.

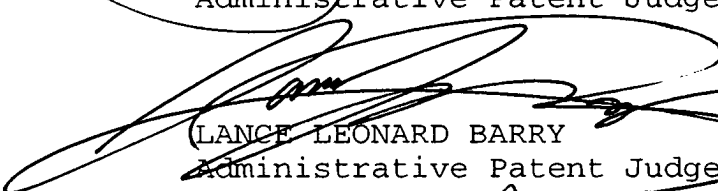
Conclusion

In view of the foregoing discussion, we have sustained the
rejection under 35 U.S.C. § 103 of claims 1-9 and 13.

No time period for taking any subsequent action in
connection with this appeal may be extended under
37 CFR § 1.136(a)(1)(iv).

AFFIRMED


JAMES D. THOMAS
Administrative Patent Judge)


LANCE LEONARD BARRY
Administrative Patent Judge)


ALLEN R. MACDONALD
Administrative Patent Judge)

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